

REMARKS

Claims 8, 17, 19-21, 23, 31, 32, and 36-39 are pending in the above-referenced application. Claims 31, 32, 38, and 39 stand rejected under 35 U.S.C. §112, claims 8, 20, 21, 23, 31, and 36-39 stand rejected under 35 U.S.C. §102, and claims 17, 19, and 32 stand rejected under 35 U.S.C. §103.

Applicant appreciates the telephone interview courteously granted by the Examiner on December 22, 2006. In the interview, claims 36 and 38 were discussed in connection with U.S. Patent No. 3,840,017 to Violante (hereinafter “Violante”) and U.S. Patent No. 4,641,652 to Hutterer, et al. (hereinafter “Hutterer”). Applicant suggested that Violante does not disclose a surgical apparatus with a handle having an unobstructed proximal opening. The Examiner agreed to consider a corresponding amendment to claim 36. Applicant further suggested that Hutterer does not disclose a suture engager movable through a nose portion bore and a cannula lumen, as recited by claim 38. The Examiner agreed.

By this paper, claims 36 and 38 have been amended in a manner consistent with Applicant’s arguments in the interview. Claims 31 and 32 have also been amended to correct antecedent basis issues. Claim 37 has been deleted. Claims 40 and 41 have been added. Applicant respectfully asserts that claims 8, 17, 19-21, 23, 31, 32, 36, and 38-41 are in condition for allowance.

REJECTION OF CLAIMS 31, 32, 38, AND 39 UNDER 35 U.S.C. §112

Claims 31, 32, 38, and 39 stand rejected under 35 U.S.C. §112, second paragraph, for indefiniteness for various antecedent basis issues. By this paper, claims 31, 32, and 38 have been amended to correct the deficiencies pointed out by the Examiner. Accordingly, Applicant respectfully requests withdrawal of the rejection.

REJECTION OF CLAIMS 8, 20, 23, 36, AND 37 UNDER 35 U.S.C. §102(B) OVER VIOLANTE

Claims 8, 20, 23, 36, and 37 stand rejected under 35 U.S.C. §102(b) as being anticipated by Violante. Applicant respectfully asserts that claim 36, as amended, possesses clear novelty over Violante. More precisely, claim 36 recites that the “passageway is provided with an opening at the handle proximal end, and wherein the opening is positioned to permit the suture to be fed into the

opening along a pathway parallel to the lumen.” This limitation is clearly disclosed by Figure 50 of Applicant’s specification, which illustrates suture being fed into the suture guide 304 along a pathway parallel to the cannula 200, and therefore parallel to the corresponding lumen.

Such a feature is not taught by Violante. Rather, Violante teaches away from such a suture entry pathway because, in Figure 2, Violante illustrates suture being fed from the spool 16 into the body 12 along a pathway distinctly angled from the axis of the needle 116, as illustrated by the phantom line representing the suture. Applicant finds no disclosure in Violante of feeding of suture into the body 12 other than via the spool 16. Clearly, the spool 16 is positioned too close to the body 12 to enable suture to be fed into the body 12 parallel to the needle 116. Even if the space between the spool 16 and the adjacent opening of the body 12 were sufficient for the suture to be somehow fed into the body 12 along the pathway recited by claim 36, Violante does not disclose loading of the surgical instrument 10 in such a manner.

Accordingly, Applicant respectfully asserts that claim 36, as amended, possesses clear novelty over Violante. Claim 37 has been deleted. Claims 8, 20, and 23 depend from 36, and are therefore novel over Violante for the same reason. Applicant respectfully requests withdrawal of the rejection.

REJECTION OF CLAIMS 31, 38, AND 39 UNDER 35 U.S.C. §102(B) OVER HUTTERER

Claims 31, 38, and 39 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hutterer. Applicant respectfully asserts that claim 36 possesses clear novelty over Hutterer. Claim 36 has been amended by this paper to broaden its scope and correct the antecedent basis issues pointed out by the Examiner. Claim 38 recites “a suture engager movable through the nose portion bore and through the cannula lumen, distally to connect to a suture and proximally to withdraw said suture engager and the connected suture.”

Such a feature is not taught by Hutterer. In Figure 2, Hutterer illustrates a loop 14 that can be used to retain suture. However, the loop 14 is not movable through a nose portion bore of a handle, or through a cannula lumen. Rather, as clearly illustrated in Figure 5, the loop 14 does not extend distally of the excision 9, but instead receives the suture at the excision 9. If Hutterer discloses a nose portion, as recited in claim 38, it must be distal to the excision 9 because claim 38 recites “a

nose portion extending distally of said recess.” Hutterer does not disclose motion of the loop 14 into the bend 8a. Indeed, if the loop 14 were drawn proximally through the bend 8a, the acutely-angled corners defined by the intersections of the bends 8a and 8b with the excision 9 would clearly cause the adjoining flexible line to break. Thus, Hutterer cannot operate in the same manner as the components recited by claim 38.

Accordingly, Applicant respectfully asserts that claim 38 possesses clear novelty over Hutterer. Claims 31 and 39 depend from claim 38, and are therefore novel over Hutterer for the same reason. Applicant respectfully requests withdrawal of the rejection.

REJECTION OF CLAIMS 17 AND 19 UNDER 35 U.S.C. §103(A) OVER VIOLANTE

Claims 17 and 19 stand rejected under 35 U.S.C. §103(a) as being anticipated by Violante. Claims 17 and 19 depend from claim 36, and are therefore nonobvious over Violante for at least the reasons set forth in the discussion of novelty of claim 36. Applicant respectfully requests withdrawal of the rejection.

REJECTION OF CLAIM 32 UNDER 35 U.S.C. §103(A) OVER HUTTERER IN VIEW OF GOLDRATH

Claim 32 stands rejected under 35 U.S.C. §103(a) as being anticipated by Hutterer in view of U.S. Patent No. 5,330,488 to Goldrath. Claim 32 depends from claim 38, and is therefore nonobvious over the combination of Hutterer and Goldrath for at least the reasons set forth in the discussion of novelty of claim 38. Applicant respectfully requests withdrawal of the rejection.

CONCLUSION

Applicant respectfully asserts that claims 8, 17, 19-21, 23, 31, 32, 36, and 38-41 are in condition for allowance. If there are any remaining issues preventing mailing of a Notice of Allowance, the Examiner is respectfully requested to contact the undersigned.

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Respectfully submitted,

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